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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,939	07/01/2005	Hendricus Antonius Hoogland	294-217 PCT/US	8051
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HOFFMANN & BARON, LLP 6900 JERICHO TURNPIKE SYOSSET, NY 11791			EXAMINER NGUYEN, THUKHANH T	
			ART UNIT	PAPER NUMBER
			1791	
			MAIL DATE	DELIVERY MODE
			01/10/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/533,939

Applicant(s)

HOOGLAND, HENDRICUS
ANTONIUS

Examiner

Thu Khanh T. Nguyen

Art Unit

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 14-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/11/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's election without traverse of group I, claims 1-13 in the reply filed on October 29, 2007 is acknowledged.

Specification

2. The disclosure is objected to because of the following informalities: the specification should not refer to the claims by number (page 1, lines 13; page 4, lines 7) because the number of the claim could be changed during the prosecution process.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3, 6-8 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Oda (4,647,274).

Oda teaches a molding apparatus, comprising a male (12) and a female (11) mold part, wherein one of the mold part is movable between an open position and a first and second closed positions to form mold cavities having different sizes (col. 2, lines 49-64) by a cylinder (5).

Although Oda teaches the purpose and the sequence of moving the mold plate are different than that of the current application. However, this is the intended use of the apparatus, and cannot be used to determine the patentability of the apparatus claims. Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. In re

Dankly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device *is*, not what a device *does*." Hewlett- Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). (Emphasis in original) It has been held that a functional limitation asserted to be critical for establishing novelty may, in fact, be an inherent characteristic of the prior art. The applicants is required to prove that the subject matter shown in the prior art does not necessarily possess the characteristics relied on. *In re Schreiber*, 128 F. 3d 1473, 1478, 44 USPQ 2d, 1432 (Fed. Cir. 1997); *See also*, *In re Spada*, 911 F 2d 705, 708, 15 USPQ 2d 1655, 1658 (Fed. Cir. 1977); *In re Best*, 562 F. 2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977); and *Ex Parte Gray*, 10 USPQ 2d 1922, 1925 (Bd. Pat. App. & Int. 1989).

In regard to claims 2-3, wherein the apparatus further comprises an injector (2) connected to an injection port (24) located on the male member (12) for supplying molding material to the mold cavity (16).

In regard to claims 6-8, wherein the movable male mold part (12) is movable to different positions by a cylinder (5), which is equivalent to the pressure member and is connected to the male mold support member (4) and positioned around the male mold part (Fig. 2, 4-5, 12).

In regard to claim 12, wherein the male mold (12) is capable of moving from a first position to a second position or a first to a second distance (h_2 , h_1) when the mold is closed.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 4-5, 9-11 and 13 are rejected under 35 U.S.C. 103(a) as obvious over Oda (4,647,274) as applied to claims 1-3 and 6-8 above, and further in view of Brown et al (5,225,213).

In regard to claims 4-5, Oda discloses a male mold part having a frustoconical portion and a corresponding shape on the female mold part (Fig. 1). Further, the shape of the molds will depend on the shape of the desired product and one of ordinary skilled in the art would have been motivated to change the shape of the molds accordingly. There is no invention in merely changing the shape or form of an article without changing its function except in a design patent. See Eskimo Pie Corp. v. Levous et al., 3 USPQ 23 and In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

In the alternative, Brown et al disclose an apparatus for differential pressure forming articles, comprises a pair of upper and lower mold plates (20, 22) each having a plurality of male and female molds (28, 94); wherein the male mold (94) having a frustoconical shape and the female mold having a corresponding shape (Fig. 7).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to modify Oda by providing the molds having frusto conical shape as taught by Brown in order to form product having a cup shape.

In regard to claims 9-11, Brown further discloses each male and female mold pair having a stripper ring (112) operatable by the spring (124). It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to modify Oda by providing a plurality of stripper rings around each pair of male and female molds as taught by

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Brown in order to shape the edge of the products after being formed by the male mold part and the female mold part.


In regard to claim 13, it would also have been obvious to one of ordinary skilled in the art to replace Oda with mold having a multi-cavity shape as taught by Brown in order to form a plurality of products at the same time. Further, the court held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced. *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu Khanh T. Nguyen whose telephone number is 571-272-1136. The examiner can normally be reached on Monday- Friday, 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gupta Yogendra can be reached on 571-272-1316. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TN


YOGENDRA K. GUPTA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700